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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,835	02/04/2002	Tsann Lin	SJO920010058US1	4835

7590

08/01/2003

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EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1773

10

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

10/066,835

Applicant(s)

LIN ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this c mmunicati n appears on the c ver sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 13-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to claims 7, 10 and 12, filed on June 27, 2003, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

3. Applicant's election with traverse of claims 1 - 12 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that using an *in situ* oxidized film is required in all claims and that a materially different process cannot be used to produce the two inventions. This is not found persuasive because the Examiner notes that product claims 1 and 12 do not require the same method limitations as claim 13 and, as evidenced by Shimizu et al. and Sasaki et al. (cited in the restriction requirement in Paper No. 5, Paragraph 5), there are many known materially different methods to form an oxidized layer. The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words (37 CFR 1.72). See MPEP § 608.01(b).

***The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.*** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

5. Applicant is advised that should claim 8 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

6. Claims 1 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mao et al. ('780 A1) in view of Sasaki et al. ('997) for the reasons of record as set forth in Paragraph No. 19 of the Office Action mailed on January 29, 2003 (Paper No. 5).
7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mao et al. in view of Sasaki et al. as applied above, and further in view of Mukoyama et al. ('463 A1) for the reasons of record as set forth in Paragraph No. 20 of the Office Action mailed on January 29, 2003 (Paper No. 5).
8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mao et al. in view of Sasaki et al. as applied above, and further in view of Jongill et al. ('412 A1) for the reasons of record as set forth in Paragraph No. 21 of the Office Action mailed on January 29, 2003 (Paper No. 5).

***Response to Arguments***

9. **The rejection of claims 7, 8 and 12 under 35 U.S.C § 112 – 2<sup>nd</sup> Paragraph**

The above noted rejection has been withdrawn in view of applicant(s) arguments, which have been found persuasive. Specifically, applicant(s) argue that one of ordinary skill in the art would be able to ascertain the scope covered by the word "about".

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**10. The rejection of claims 1 - 9 under 35 U.S.C § 103(a) – Mao et al. in view of Sasaki et al.**

**The rejection of claims 10 and 11 under 35 U.S.C § 103(a) – Mao et al. in view of Sasaki et al. and Mukoyama et al.**

**The rejection of claim 11 under 35 U.S.C § 103(a) – Mao et al. in view of Sasaki et al. and Jongill et al.**

Applicant(s) argue(s) that the metal oxide films are different than the claimed oxidized metal films. The examiner respectfully disagrees.

The Examiner notes that attorney arguments are not evidence and applicants are invited to submit an affidavit or declaration showing that the films used by Sasaki et al. are patentably distinct from the presently claimed “oxidized metallic films”.

Applicants further argue that “the thickness of the gap layer taught by Sasaki et al., however, is necessarily ten times thicker than that of the claimed invention”. The Examiner respectfully disagrees.

As clearly stated in the rejection of record, Sasaki et al. disclose thickness values meeting applicants’ presently claimed thickness limitations.

### ***Conclusion***

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
KMB  
July 25, 2003

  
HOLLY RICKMAN  
PRIMARY EXAMINER, acting SPE